

REMARKS

In the Office Action mailed December 7, 2005 in the above case, claims 1-20 were examined. The Office Action noted the priority claim to European Patent Application No. 02425609.1, for which the specification did not contain a reference although the Declaration and Filing Receipt identified the priority document, required an amendment to the specification. Claims 1, 9, 12-16 and 18 are rejected under 35 U.S.C. 112, 2nd paragraph, for lacking antecedent basis. Claims 1-7, 9-10 and 14-19 are rejected as anticipated by *Skeirik* (U.S. Patent No. 5,197,114). Claim 8 is rejected as rendered obvious by *Sheirik* in view of *Masuda* (U.S. Patent No. 5,165,010). Claims 11-13 and 20 are rejected as obvious over *Sheirik* in view of *Okamoto* (U.S. Patent No. 6,582,841).

Reconsideration and withdrawal of these rejections is respectfully requested in view of the above amendments and the remarks which follow.

A. Amendment to the Specification Adds Priority Information from Declaration as Originally Filed and Listed on Filing Receipt.

The Declaration as filed and the Filing Receipt as mailed included reference to a priority claim to European Patent Application No. 02425609.1. Consistent with the requirement noted in the Office Action, the specification has been amended above to include a reference to European Patent Application No. 02425609.1. In view of the prior reference to this priority claim in the Declaration and the Filing Receipt, neither a petition nor a petition fee is required.

B. Rejection of Claims 1, 9, 12-16 and 18 Under 35 U.S.C. § 112, 2nd Paragraph, is Addressed.

Claims 1, 5, 9, 14 and 18 have been amended to address phraseology relating to lack of antecedent basis. In most cases, "the" has been replaced with "a" or "an". Withdrawal of the § 112, 2nd paragraph rejections is respectfully requested.

C. Anticipation Rejection of Claims 1-7, 9-10 and 14-19 over *Sheirik* is Addressed

Claims 1-7, 9-10 and 14-19 stand rejected as anticipated by U.S. Patent No. 5,197,114 to *Sheirik*. This rejection is respectfully traversed in view of the amendments to independent claims 1 and 14, which now recite

wherein said controlled system comprises at least one fuel cell, and wherein said at least one control parameter is represented by a voltage generated by said at least one fuel cell.

Sherik contains no teaching or suggestion—indeed, there is no indication at all in *Sherik*—that the *Sheirik* control method is particularly useful in conjunction with fuel cells. Fuel cells are not mentioned in *Sheirik*. The particular usefulness of the *Sheirik* control method is not mentioned above any other type of control method in the context of controlling fuel cells. Thus, as amended, independent claims 1 and 14 are patentably distinct over *Sherik*. Dependent claims 2-7, 9-10 and 13-19 contain this same patentably distinct feature over *Sherik*.

Accordingly, withdrawal of the rejection of claims 1-7, 9-10 and 14-19 is proper and respectfully requested.

D. Obviousness Rejection of Claim 8 over *Sheirik* in view of *Masuda* is Addressed

Claim 8 stands rejected as being unpatentable over *Sheirik* in view of U.S. Patent No. 5,165,010 to *Masuda*. Claim 8 is indirectly dependent upon amended claim 1 and therefore also the requirement of amended claim 1 in which the “controlled system comprises at least one fuel cell” and the “at least one control parameter is represented by a voltage generated by said at least one fuel cell.”

While *Masuda* does teach the use of a controller, like *Sheirik*, there is no teaching in *Masuda* which would provide the necessary motivation to one of skill in the art of fuel cell control to look to either *Masuda* or *Sheirik*, let alone combine the references. As discussed in detail below in connection with the obviousness rejection of claims 11-13 and 20, in the absence of such evidence of motivation, a *prima facie* obviousness of claim 8 is not established. Withdrawal of the rejection of claim 8 is therefore respectfully requested.

E. Obviousness Rejection of Claims 11-13 and 20 over *Sheirik* in view of *Okamoto* is Addressed

Claims 11-13 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sheirik* in view of U.S. Patent No. 6,582,841 to *Okamoto*. This rejection is respectfully traversed.

Claim 1 has been amended to include the limitations of previous claims 11 and 12, which are now cancelled. Claim 13 has been amended to properly

depend from claim 1. Similarly, claim 14 has been amended to include the limitations of claim 20, which is now cancelled. New method claim 21 has been presented for examination that corresponds to apparatus claim 13.

It is well settled in the law that it is not sufficient to show that references “can be” or “could be” combined to establish a *prima facie* case of obviousness. It is further well settled that the test for combining references is whether or not there is some motivation in the references themselves that would suggest the combination. There is no “obvious to try” or “can be combined” standard when the hypothetical combination of references is set forth in a 35 U.S.C. § 103(a) rejection. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990)

With respect to the rejection of claim 11, it is respectfully submitted that the citation provided by the Examiner is not a suggestion for combining the teachings of the *Sheirik* reference with any other reference but merely a general statement about the objective of the invention taught therein. There are no specifics of what might be a particularly good candidate system for the controlled method of *Sheirik* and certainly no mention of controlling fuel cells as now claimed in claims 1 and 14, as amended.

With respect to the rejection of claims 12 and 13, it is respectfully submitted that the cited FIG. 20, element 2002 proves too much. Element 2002 recites that “voltage to a motor, flow of heating steam, position of temperature control valve, current to an electric heater, etc” are all good candidates to be used with the disclosed control method. In other words, anything at all may be used in the *Sheirik* control method.

There is absolutely no indication, however, that the *Sheirik* control method is particularly useful in conjunction with fuel cells apart from any other system. Fuel cells are not mentioned in *Sheirik*. The particular usefulness of the *Sheirik* control method is not mentioned above any other type of control method in the context of controlling fuel cells.

In addition, there is no mention of the other claimed control limitations in *Okamoto*, although it is noted that *Okamoto* was not cited for this purpose. *Okamoto* recites a single sentence regarding the use of neural networks for

generating hydrogen gas flow rates at column 8, lines 31-34 that is not related to the present invention as claimed.

Thus, it is deemed that the *Sheirik* and *Okamoto* references are being combined in a 35 U.S.C. § 103(a) rejection because they can be combined when the teachings of the present invention are used as a guide for that combination. This is impermissible hindsight and the rejection under 35 U.S.C. § 103(a) fails absent some suggestion of the combination.

Withdrawal of the rejection of claims 11-13 and 20 is respectfully requested. The limitations of claims 11-12 now appear in amended claim 1. The limitations of claim 20 now appear in amended claim 14. New claim 21 is deemed to be allowable for the reasons given with respect to claim 13. The remaining dependent claims are deemed to be allowable as being dependent upon an allowable base claim.

F. Conclusion.

In view of the above amendments, all claims now being in form for allowance, such action is respectfully requested. Should any issues remain, the Examiner is kindly asked to telephone the undersigned.

Although no fees are believed be due, please charge any fees herewith to Deposit Account No. 50-1123.

Respectfully submitted,



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